

Application No. 09/954,646  
Amendment dated October 30, 2007  
Reply to Office Action of July 30, 2007

**REMARKS**

**Reconsideration And Allowance  
Are Respectfully Requested.**

Claims 50, 51, 55-60, 62 and 65-67 are currently pending. Claims 1-49, 52-54, 61, 63, 64 and 68-78 have been cancelled by way of prior amendments. Claims 50 and 60 have been amended. No new matter has been added. No new claims have been added. Reconsideration is respectfully requested.

With regard to the outstanding rejection, claims 50, 51, 55-60, 62 and 65-67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Reissue No. 34,936 to Campbell et al. (Campbell) in view of U.S. Patent No. 5,562,316 to Kandany and U.S. Patent No. 5,195,540 to Shiber. This rejection is respectfully traversed in view of the preceding amendments and the remarks which follow.

As amended, claim 50 now defines a method of marking a body site. The method includes the steps of providing a marker element applier having a proximal end, a distal end, and a side exit port. The side exit port is positioned between the proximal end and the distal end of the marker element applier. A marker element comprising a radiopaque material is then provided. The marker element is adapted to be deployed from the marker element applier. The side exit port is then positioned adjacent a site from which a biopsy site has been taken. Thereafter, a force is applied to the marker element disposed within the marker element applier to radially deploy the marker element through the side exit port of the marker element applier such that no part of the marker element extends outside the body.

In contrast to the claimed invention, the primary reference of Campbell fails to disclose at least a marker element applier having a proximal end, a distal end and a side exit port positioned between the proximal end and the distal end wherein a marker element may be radially deployed through the side exit port of the marker element applier.

Rather, Campbell discloses an animal marker implanting system utilizing a rather conventional hollow tube having an entrance and an exit opening. Although the exit opening 21 is formed in the shape of an inclined edge 22, the exit opening is certainly not a side exit port positioned between the proximal end and the distal end of the marker element applier which provides for radial deployment of the marker element therethrough. Rather, the inclined edge 22 of the exit opening 21 is provided for forming a sharp point for permitting the tube to easily penetrate an animal's skin. As such, an animal marker 30 is not radially deployed from the implanting instrument, but is applied axially along the longitudinal axis of the implanting instrument.

The Office Action attempts to remedy this situation through the citation of Kandany, arguing that Kandany discloses "a closed distal end and a side exit port defining a plane, the plane being parallel to the longitudinal axis of the tube, wherein the side port is located adjacent a distal end of said tube for the introduction of pellets of interest". However, a careful review of Kandany reveals that Kandany does not disclose a marker element applier having a proximal end, a distal end and a side exit port positioned between the proximal end and the distal end for radially deploying a marker element through the side exit port. Rather, Kandany discloses an outer tube mounted concentrically about a cannula 104. The cannula 104 moves within the outer tube for releasing a drug pellet through the distal opening at the tip of the outer tube. As such, Kandany does not disclose a marker element including a side exit port as claimed, but rather discloses a delivery device utilizing a cannula 104 for maneuvering a pellet longitudinally along the length of an outer tube 102 until such a time that the cannula 104 is beyond the extent of the outer tube at which time the pellet may be released from the delivery device. This is directly in contrast with the claimed invention, where a side exit port is actually provided within the marker element.

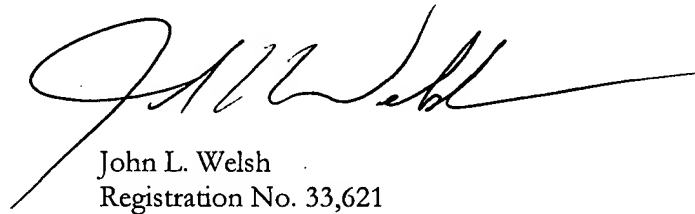
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With the foregoing in mind, it is Applicants' opinion amended claim 50 overcomes Campbell, Kandany and Shiber, and Applicants respectfully request the rejection of claim 50 be withdrawn.

As to independent claim 60, this claim has similarly been amended so as to specifically note radial deployment of the marker element. As such, and considering the remarks presented with regard to amended claim 50, it is Applicants' opinion claim 60 also overcomes the references of record. As to those claims dependent upon independent claims 50 and 60, they are also believed to overcome the references of record for at least the reasons presented above.

It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact Applicants' representative at the below number.

Respectfully submitted,



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